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WYATT, TARRANT & COMBS, LLP
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EXAMINER

WERNER, JONATHAN S

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3732

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

1. This action is in response to Applicant's amendment received 4/9/08.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-3, 5-6, 8-10, 12 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel (US 6343932) in view of Subelka et al. (US 2003/0060532) and further in view of Cohen (US 4,795,527). Wiesel discloses a restoration procedure kit with a unit package for carrying and applying a dental composite (Column 6, lines 5-18). The dental composite (16) is carried on a carrier film (12) with an enlarged central portion (14) that is covered by a film covering (18) that is releasably sealed to the carrier film adjacent the composite (Figs. 1 and 2). There is a delivery side and a spatulating side. The cover is in direct contact with the composite and is designed with a surface of non-adhesive release material (Column 4, lines 53-58). It is also disclosed that a non-adhesive release coating may be applied for easier release (Column 5, lines 1-4). Wiesel discloses that the carrier pad can be made from medical grade silicone or acrylic (column 4, lines 4-8). Although Wiesel is silent as to specifying polyester as a material of choice, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to substitute the use of

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medical grade silicone or acrylic for polyester as the preferred material of the carrier film since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, Examiner further notes that medical grade silicone, for example, functions to perform the same intended purpose as Applicant's own polyester – namely they are both strong and pliable as required by Applicant's specification (see Applicant's specification; page 8, lines 23-25). The carrier film is an elongated strip with laterally and longitudinally extending incisal tabs (22 and 24) from the central portion that are able to fold under the central portion of the carrier film and also wrap around the edges of the teeth with applied since they can be cut to fit specific lengths (Figs. 2 and 3, Column 3, lines 60-65). The unit packages can be made singly, or come in a plurality of adjacent packages in a long roll that can be individually cut out when needed (Column 3, lines 60-64). The carrier film can be translucent if light activation of the applied composite is necessary (Column 4, lines 21-24). The unit package also includes an outer strip (20), on which the carrier strip is disposed, and is releasably sealed to the adjacent cover. Wiesel does not disclose that the unit dose disposed on the delivery side of the carrier is curable dental restorative composite. However, it is noted that Column 6, lines 5-18 of Wiesel indicates that the delivery system can be used to deliver other common dental agents. Specifically, Subelka et al. teaches in paragraphs 0027-0028 a carrier (10) which holds a unit dose of such a dental agent - namely a dental restorative composite (11). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to

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make the material disposed on the carrier a dental restorative composite in order to use said material in a tooth restoration procedure. Furthermore, Wiesel shows the entire bottom length of the delivery unit (22 or 24) is an underlying incisal tab. The terminal ends of the same tabs are embrasure tabs since they can be cut to fit and capable of wrapping around the teeth to occupy the space in the embrasures. However, Wiesel does not explicitly disclose that the delivery kit is T-shaped. Cohen teaches a dental carrier film that is appropriately T-shaped (Figure 7; column 3, lines 20-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to make the carrier film T-shaped in order to position said carrier on the tooth so that it contacts both the end and either the front or rear face of said tooth as taught by Cohen. Additionally, the carrier of Subelka et al., as shown especially in Figure 4, has a cover (50) that is spaced from the composite (11) and not in direct contact therewith. Figures 6-7 further show a plurality of unit packages (10) which are dome-like and disposed serially in side-by-side relation on a packaging strip. Lastly, Subelka et al. disclose the use of perforations (70) on the packaging strip to separate the compules (Figure 6).

Response to Arguments

3. Applicant's arguments filed 4/9/08 have been fully considered but they are not persuasive.

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4. Applicant first remarks that Wiesel fails to show that the unit dose disposed on the delivery side of the carrier is curable dental restorative composite. Examiner had previously indicated as much in the previous rejection, and never relied on the disclosure of Wiesel to teach this feature. Examiner reminds Applicant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically in this case, the Subelka reference was relied on to teach a carrier (10) which holds a unit dose of such a dental agent - namely a dental restorative composite (11). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to make the material disposed on the carrier of Wiesel a dental restorative composite as taught by Subelka in order to use said material in a tooth restoration procedure. It was also previously noted that although Wiesel does not disclose that the unit dose disposed on the delivery side of the carrier is curable dental restorative composite, Wiesel does indicate that the delivery system can be used to deliver other common dental agents (column 6, lines 5-18). Applicant remarks that "a dental restorative is simply not the same type of tooth treatment clearly of concern to Wiesel in this paragraph." Examiner does not understand the point of Applicant's argument inasmuch that Examiner never tried to show that the carrier of Wiesel explicitly dealt with dental restorative composites - in fact the contrary is true as previously discussed. However, it is the Examiner's position that since the device of Wiesel is capable of having "substantially any other substance ... applied using the

invention," the teaching of Subelka as applied to the Wiesel reference clearly would not make the device of Wiesel inoperable.

5. Applicant next remarks that none of the cited references teach that the material of the carrier film is polyester. However, as noted in the rejection above, although Wiesel is silent as to specifying polyester as a material of choice, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to substitute the use of medical grade silicone or acrylic for polyester as the preferred material of the carrier film since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, Examiner further notes that medical grade silicone, for example, functions to perform the same intended purpose as Applicant's own polyester – namely they are both strong and pliable as required by Applicant's specification (see Applicant's specification; page 8, lines 23-25). Examiner further points out that Applicant's own specification explicitly sets forth that other similar materials can be substituted for the polyester (see Applicant's specification; page 12, lines 7-8). Applicant alleges that "the polyester of the instant invention is necessary to allow for removal from the cured composite after sculpting." However, Examiner holds that such an allegation has no support based from Applicant's originally filed disclosure. Instead, it is clear from said disclosure that any material that is similarly strong and pliable can act as a suitable substitute for the claimed polyester.

6. Lastly, Applicant remarks that neither Wiesel nor Subelka disclose a generally T-shaped design of any type. However, Examiner again reminds Applicant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In this case, said teaching of a T-shaped design for the carrier film was shown by Cohen. Notably, Cohen teaches a dental carrier film that is appropriately T-shaped (Figure 7; column 3, lines 20-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to make the carrier film T-shaped in order to position said carrier on the tooth so that it contacts both the end and either the front or rear face of said tooth as taught by Cohen. To this end, Applicant argues that "[t]here is nothing within this reference [Cohen] of the necessity of or even the possibility of providing such a configuration for the purpose of applying a restorative composite to a tooth. Such a configuration is but one manner of delivering a tooth etchant to a tooth surface." However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN WERNER whose telephone number is (571)272-2767. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Melba Bumgarner/
Primary Examiner, Art Unit 3732

/Jonathan Werner/
Examiner, Art Unit 3732

6/29/08